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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,382	06/23/2003	Howard A. Fromson	FRO/175/US	7964
2543	7590	03/30/2004	EXAMINER	
ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103			FUNK, STEPHEN R	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/601,382	FROMSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen R Funk	2854	<i>PR</i>

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-32 and 34 is/are rejected.

7) ☒ Claim(s) 33 is/are objected to.

8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_.

On page 1 lines 4 - 6, page 2 line 28, and page 4 line 14 the status of the parent applications should be updated.

The disclosure is objected to because of the following informalities: On page 7 line 23 “pined” should presumably be --pinned--. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no support in the specification for “detecting said side edges and controlling the application . . . in response to said detections of said side edges” as is recited in claim 30. See Figure 2 and page 7 lines 14 - 27 in the specification. The detecting of the leading edge by detector 26 does not appear to detect the side edges.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 17, 19, 21 - 24, 26, 31, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamoshita (JP 2001-212927) in view of Usui (US 2002/0195013) and Matsumoto et al. (US 4,396,703).

Kamoshita teaches jetting (Abstract) a first solvent composition (paragraph 15) in a desired pattern onto an oleophilic coating (paragraphs 31 - 39) thereby dissolving away the coating and exposing a hydrophilic substrate (paragraphs 29 - 30). See also Figure 1-1 of Kamoshita, for example. Kamoshita does not teach separately applying a second solvent composition to the leading and trailing ends of the plate.

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Usui teaches the desirability of hydrophilizing all the edges (ends and sides edges) of a plate to prevent unwanted ink from adhering thereto. See the Abstract and paragraphs 6, 41, 44, 47, and 48 of Usui, for example.

Matsumoto et al. teach preventing ink from adhering to unwanted portions by applying a solvent composition to remove an oleophilic coating. See column 7 line 61+ and column 9 line 15+ of Matsumoto et al., for example.

It would have been obvious to one of ordinary skill in the art to provide the method of Kamoshita with the step of applying a second solvent composition to the ends and edges of the plate in view of Usui and Matsumoto et al. to dissolve away unwanted portions of the oleophilic coating to prevent ink from adhering thereto.

With respect to claims 2, 6, 10, and 32 Usui teaches using a sponge (an absorbent pad) to apply the second solvent.

With respect to claims 3, 4, 7, 8, 11, and 12 it would have been obvious to one of ordinary skill in the art to utilize the same solvent for both applications to be more economical and provide uniform results from both applications.

With respect to claims 13 - 17 see paragraphs 32, 38, and 53 of Kamoshita, for example.

With respect to claims 19, 21 - 24, and 26 see paragraph 15 of Kamoshita.

With respect to claims 31 and 34 the brush or roller disclosed by Usui is considered to fall under the means plus function language of the means for separately applying the second solvent. See page 6 lines 22 - 24 and page 7 lines 7 - 8 in applicant's specification.

With respect to claim 32 the means for contacting is considered to encompass any structure implied by Usui, lacking any teaching to the contrary.

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Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamoshita in view of Usui and Matsumoto as applied to the claims above, and further in view of Deutsch et al. (US 2002/0104455).

Kamoshita does not teach a phenolic resin oleophilic coating. Note that Kamoshita does teach in paragraph 15 that the coating should be dissolvable in an aqueous alkaline solution. Deutsch et al. teach a similar method wherein the oleophilic coating is a phenolic resin. See paragraphs 6 and 66 - 69 of Deutsch et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Kamoshita, as modified by Usui and Matsumoto et al., with a phenolic resin oleophilic coating in view of Deutsch et al. to achieve both the dissolvability and durability expected from phenolic resins.

With respect to claim 20 Kamoshita does not teach a sodium metasilicate aqueous solution. However, see paragraph 15 of Kamoshita. Deutsch et al. teach the conventionality of using sodium metasilicate in the aqueous solution. See paragraph 68 of Deutsch et al. It would have been obvious to one of ordinary skill in the art to provide the method of Kamoshita, as modified by Usui and Matsumoto et al., with a sodium metasilicate solution in view of Deutsch et al. to achieve the desired dissolvability of the oleophilic coating.

Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamoshita in view of Usui and Matsumoto as applied to claims 1 - 17, 19, 21 - 24, 26, 31, 32, and 34 above, and further in view of Deutsch et al. and Kanda et al. (US 5,344,739).

Neither Kamoshita or Deutsch et al. teach a solution comprising both sodium metasilicate and benzyl alcohol. Note the comments above with respect to claim 20 and Deutsch et al. Kanda et al. teach a solution comprising both sodium metasilicate and benzyl alcohol. See

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column 9 lines 21 - 41 of Kanda et al. It would have been obvious to one of ordinary skill in the art to provide the method of Kamoshita, as modified by Usui and Matsumoto et al., with a sodium metasilicate and benzyl alcohol solution in view of Deutsch et al. and Kanda et al. to achieve the desired dissolvability of the oleophilic coating.

Claims 28 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamoshita in view of Usui and Matsumoto as applied to claims 1 - 17, 19, 21 - 24, 26, 31, 32, and 34 above, and further in view of Daigneault et al. (US 6,334,678).

Neither Kamoshita or Usui teach detecting the ends of the plate. Daigneault et al. teach an ink jetting method including detecting the leading end of a substrate and controlling application by the ink jet in response thereto. See column 3 line 45+ and Figure 1 of Daigneault et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Kamoshita, as modified by Usui and Matsumoto et al., with the step of detecting the leading end of the plate in view of Daigneault et al. so as to control subsequent applications of the solvents to the corresponding portions of the plate.

With respect to claims 29 and 30 it would have been obvious to one of ordinary skill in the art to utilize the detecting of the leading end to trigger application of the solvent to the edges of the plate in view of Usui teaching applying the second solvent to all edges of the plate.

Claims 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowability: With respect to claim 33 the means for reciprocating the pad across the ends of the plate, as disclosed by

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applicant or an equivalent thereof, is not deemed to be taught or suggested by Usui or the other prior art of record.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

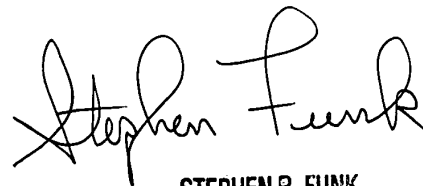
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164. The examiner can normally be reached M - F, except Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SRF  
March 19, 2004

A handwritten signature in black ink that reads "Stephen Funk". The signature is stylized with a large, looped "S" and a cursive "Funk".

**STEPHEN R. FUNK  
PRIMARY EXAMINER**